

Modified PTO/SB/33 (10-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number

Q64528

Mail Stop AF
Commissioner for Patents
P.O. Box 1450 Alexandria, VA 22313-1450

Application Number

09/854,666

Filed

May 15, 2001

First Named Inventor

Kaoru UCHIDA

Art Unit

2134

Examiner

TRAN, Ellen C.

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal

The review is requested for the reasons stated on the attached sheets.

Note: No more than five (5) pages may be provided.

☒ I am an attorney or agent of record.

Registration number 44,186

Signature

Ronald Kimble

Typed or printed name

(202) 293-7060

Telephone number

April 19, 2006

Date



PRE-APPEAL BRIEF REQUEST FOR REVIEW

Q64528

U.S. Application No. 09/854,666

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q64528

Kaoru UCHIDA

Examiner: TRAN, Ellen C.

Appln. No.: 09/854,666

Group Art Unit: 2134

Filed: May 15, 2001

Confirmation No.: 1139

For: IDENTIFICATION SYSTEM AND METHOD FOR AUTHENTICATING USER
TRANSACTION REQUESTS FROM END TERMINALS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the new Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Advisory Action dated February 17, 2006, Applicants file this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicants turn now to the rejections at issue:

Claims 1-29 are all the claims pending in the application. These claims stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Musgrave et al. (U.S. Patent No. 6,202,151) (hereinafter '151) in further view of Glass et al. (U.S. Patent No. 6,332,193 (hereinafter '193)). Applicants respectfully request the Pre-Appeal Brief conference panel to withdraw the foregoing rejection in view of clear errors.

A. The Examiner has not provided disclosure in Glass et al. as to where a user identifier is included in a transaction request message.

Applicants respectfully submit, as indicated by the Examiner's comments, or lack thereof in the April 21, 2005 and October 19, 2005 Office Actions that the Examiner has not provided disclosure in Glass et al. as to where a user identifier is included in a transaction request message. Glass et al. is related to secure transmission of biometric data over a network (see Abstract). In particular, preventing a photo of a user from being tampered with or substituted during transmission (see col. 2, lines 27-35). Glass et al. transmits a photo image as well as a code related to the image (see col. 5, lines 46-66). The photo image or associated code are not user identifiers as claimed.

The Examiner states in the October 19, 2005 Office Action that the token which is included within the transaction request message of Glass et al. serves as a user identifier because it identifies the transaction in which contains the user identity (citing '193 col. 3, lines 60-67; and stating that this section explains how the token is provided to the camera or other sensor before the transaction request message).

Applicants respectfully traverse this argument. In particular, the token cited by the Examiner defines a unique transaction and couples the biometric data to the transaction. The purpose of this token is *not as a user identifier*, but for preventing the use of the biometric data at a later time (see col. 3, lines 60-67). Also, there is no suggestion that this token could or would be mapped in a database to registered biometrics data as claimed in the present application.

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In the February 17, 2006 Advisory Action, the Examiner newly argues that Musgrave describes in the Abstract biometric data being stored in a biometric database. However, the token in Glass is not biometric data. Nor, as argued above, is it a user identifier. Accordingly, the arguments presented in the Office Actions are incorrect on this point.

B. The Examiner has not shown how the references teach transmitting an authentication request message containing said biometrics data and said user identifier to said network.

The independent claims recite a feature where an authentication request message containing said biometrics data [and said user identifier] is transmitted to the network.

The Examiner argues that this feature is shown by Glass et al. where “the file with code is output to a network for transfer to an authentication server system”, citing col. 3, lines 51-59. Applicants note that claim 1 recites that this feature is performed by the electronic commerce service provider (ECSP). In the Examiner’s scenario, in Glass et al., the camera image sent to the network would be from an “end terminal” rather than from an ECSP (different physical entities). Further, again, as discussed above, there is no disclosure of the user identifier in Glass et al.

In the October 19, 2005 Office Action, the Examiner states that the Office disagrees (*sic*) the references should be applied in combination, as noted in the below and in a previous Office Action Musgrave discloses the ECSP transmitting the authentication request (citing ‘151 col. 5, lines 36-60), and arguing that this section shows the receiver sends the biometric certificate for

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authentication to a biometric certificate management system (BCMS). This new argument now including Musgrave is also put forth in the February 17, 2006 Advisory Action.

First, Applicants note that in both the April 21, 2005 and October 19, 2005 Office Actions, the Examiner explicitly stated that this feature was not disclosed by Musgrave. Further, under the new analysis put forth by the Examiner in the October 19, 2005 Office Action, it is not clear why one of ordinary skill in the art would look to Glass et al., and its feature of a camera image sent to the network from an "end terminal" (rather than from an ECSP as claimed), for incorporation into the Musgrave device. The Examiner attempts to answer this in the Advisory Action by stating that the motivation to combine the references is to increase user flexibility while using biometrics to process transactions over a network. Applicants fail to see how this conclusory statement (made in the Advisory Action) meets the standards of *In re Sang-Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002) "The factual inquiry whether to combine references must be thorough and searching ... It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with . . . The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to

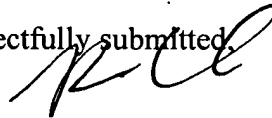
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select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references"). In this case, the Examiner has not met this burden with the conclusory statement.

Respectfully submitted



Ronald Kimble
Registration No. 44,186

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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